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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,560	12/08/2003	Gary W. Groves	1316N001633	4251

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EXAMINER

BURCH, MELODY M

ART UNIT PAPER NUMBER

3683

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,560

Applicant(s)

GROVES ET AL

S

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 08 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/3/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "36" has been used to designate both the rebound outlet and the guide rod in figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first and second blowoff valves recited, for example, in claim 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Examiner notes that only a blowoff passage is shown in figure 6.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

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number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

4. The disclosure is objected to because of the following informalities: On pg. 11 the phrase "In the above formula: ... AO = diameter of bore 124 BV = area of orifice 86 or 94 which is open P = pressure is unclear since the formula does not include parameters "AO", "BV", and "P".

Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification lacks proper antecedent basis for the term "variable blowoff valve" first claimed in line 2 of claim 6. The disclosure merely describes a blowoff level on pg. 11 of the specification and shows a blowoff passage 122 in figure 6.

Claim Objections

6. Claims 13-17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims depend from a claim 12 which does not exist. Examiner has interpreted claims 13-15 as depending from claim 6 for examining purposes.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claims 13 and 14. The phrase "said second blowoff valve" in lines 2-3 of claim 13 lacks proper antecedent basis. A similar problem exists in claim 14.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-11 and 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6464048 to Groves et al.

Re: claim 1. Groves et al. show in figures 1, 2, and 5 an adjustable shock absorber comprising a pressure tube 16 defining a working chamber 24,26, a piston rod 14 extending through the pressure tube and into the working chamber, a piston 12 slidably disposed within the pressure tube and connected to the piston, the piston dividing the working chamber into an upper working chamber 24 and a lower working chamber 26, a valve assembly 22 separate from the piston in communication with the upper and lower working chambers, the valve assembly including a first variable orifice 94 in communication with the upper working chamber for controlling flow from the upper working chamber and a second variable orifice 84 in communication with the lower working chamber for controlling flow from the lower working chamber.

Re: claim 2. Groves et al. show in figure 2 the limitation wherein the valve assembly includes a solenoid valve 48 having means for controlling the first variable orifice.

Re: claim 3. Groves et al. figure 2 show the limitation wherein the means for controlling the first variable orifice includes a spool valve 62.

Re: claim 4. Groves et al. show in figure 2 the limitation wherein the solenoid valve includes means 62 for controlling the second variable orifice.

Re: claim 5. Groves et al. show in figure 2 the adjustable shock absorber according to Claim 4 wherein, said means for controlling said first and second orifices include a spool valve 62.

Re: claim 6. Groves et al. show in figures 2 and 5 the adjustable shock absorber according to Claim 1 wherein, said valve assembly includes a first variable blowoff valve in communication with said upper working chamber to the same extent as Applicant's.

Re: claim 7. Groves et al. show in figures 2 and 5 the adjustable shock absorber according to Claim 6 wherein, said first variable blowoff valve is in communication with said lower working chamber to the same extent as Applicant's.

Re: claim 8. Groves et al. show in figures 2 and 5 the adjustable shock absorber according to Claim 6 wherein, said shock absorber includes a reserve tube 18 defining a reserve chamber 36, said first variable blowoff valve being in communication with said reserve chamber to the same extent as Applicant's.

Re: claims 9 and 15. Groves et al. show in figure 2 the limitation wherein the valve assembly includes a solenoid valve 58,62,70 having means for controlling said first variable orifice.

Re: claims 10, 11, 16, and 17. Groves et al. show in figure 2 the limitation wherein the means for controlling the first variable orifice includes a spool valve 62.

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Re: claim 13. Groves et al. show in figures 1, 2, and 5 the adjustable shock absorber wherein said first variable blowoff valve is in communication with said lower working chamber and said second blowoff valve is in communication with said upper working chamber to the same extent as Applicant's.

Re: claim 14. Groves et al. show in figures 1, 2, and 3 the adjustable shock absorber wherein, said shock absorber includes a reserve tube 18 defining a reserve chamber 36, said first and second blowoff valves being in communication with said reserve chamber to the same extent as Applicant's.

Re: claim 18. Groves et al. show the limitation wherein the first variable orifice is in communication with the lower working chamber as shown in figure 5.

Re: claim 19. Groves et al. show the limitation wherein the second variable orifice is in communication with the upper working chamber as shown in figure 5.

Re: claim 20. Groves et al. show the limitation wherein the shock absorber includes a reserve tube 18 defining a reserve chamber 36, the first and second variable orifices being in communication with the reserve chamber as shown in figures 1 and 5.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 4266639 to Schloth teaches a similar absorber having a valve assembly separate from the piston.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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October 21, 2004

Melody M. Bruch
10/21/04